

REMARKS

Please reconsider the application in view of the above amendment and the following remarks. Applicant thanks the Examiner for considering the present application.

Disposition of Claims

Claims 2-4, 6-10, and 13-14 are currently pending in this application. Claims 2-4, 6-10, and 14 are withdrawn from consideration due to the Applicant's election of Species III pertaining to claim 13 in the Response filed on May 24, 2007. Claims 2, 4, 6-10, and 13-14 are independent.

Claim Amendment

Claim 13 has been amended to clarify that a client computer sends a print request *directly* to the second printer. Support for the amendment may be found, for example, in Figure 11 and the associated text of the Specification as filed. No new matter has been added by the aforementioned amendment.

Rejection under 35 U.S.C. § 103

Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,337,745¹ ("Aiello") in view of U.S. Patent No. 6,184,996 ("Gase"), and further in view of U.S. Patent No. 6,791,703 ("Maeda"). To the extent that this rejection applies to amended claim 13, the rejection is respectfully traversed.

Turning to the rejection, to establish a prima facie case of obviousness...the prior art reference (or references when combined) must teach or suggest all the claim limitations." See

M.P.E.P. §2143. The Applicant respectfully asserts that the cited references, whether considered separately or in combination, do not teach or suggest all the limitations recited in amended independent claim 13.

Amended independent claim 13 recites, *inter alia*, “[a] system comprising... a first printer configured to provide a print acceptance screen to a client computer, the *client computer configured to send a new print request directly to a second printer* using the print acceptance screen provided by the first printer, wherein the new print request specifies a peripheral device on which data to print is stored; and the second printer is configured to request the data to print from the peripheral device and print the data upon receipt from the peripheral device.” Thus, the aforementioned limitations explicitly require at least the following: (i) direct communication between the client computer and the second printer when sending the new print request (*i.e.*, new print request is not sent via the first printer); and (ii) at least two printers, such that at least one printer (*i.e.*, the first printer) *provides the print acceptance screen to the client computer*. The Applicant respectfully asserts that Aiello, Gase, and Maeda, whether considered separately or in combination, fail to teach or suggest at least the aforementioned limitations as required by amended independent claim 13.

Aiello's failure to teach or suggest sending a new print request directly to a second printer

As discussed previously, amended independent claim 13 requires a system that comprises a *client computer configured to send a new print request directly to a second printer* using the print acceptance screen provided by the first printer (*i.e.*, new print request is not sent via the first printer. The Examiner relies solely on Aiello to teach the aforementioned limitation.

¹ Although the Office Action mailed on June 15, 2007 cites U.S. Patent No. 6,377,745, the Examiner confirmed via telephone on July 5, 2007 that he intended to cite U.S. Patent No. 6,337,745,

However, the Applicant respectfully disagrees with at least the Examiner's interpretation of Aiello.

Specifically, in contrast to the claimed invention, the portion of Aiello (*i.e.*, column 5) relied upon by the Examiner explicitly teaches that "*the Queue Manager notifies the selected output manager that a print job is ready*, and the output manager begins reading ... the print job...[such that] the output manager may be a workstation with a printer adapter card to support the attached printer." Thus, Aiello requires the output manager to act as an intermediary between the queue manager and the printer when sending print jobs from the queue manager to the printer. Said another way, the queue manager *indirectly* sends print jobs to the printer via the output manager. Aiello, column 5, lines 60-67. On page 3 of the Office Action mailed on June 15, 2007, the Examiner equates the queue manager of Aiello with the client computer of the claimed invention. Accordingly, Aiello fails to teach or suggest a client computer that sends a new print request directly to a second printer as required by amended independent claim 13.

The combination of Aiello and Gase is unobvious

As discussed previously, amended independent claim 13 requires two printers (*i.e.*, first printer and second printer), such that the first printer provides the print acceptance screen to the client computer. The Examiner acknowledges on page 3 of the Office Action mailed on June 15, 2007 that Aiello does not disclose a printer capable of providing a print acceptance screen and relies on Gase to teach what Aiello lacks. Specifically, the Examiner asserts that at the time of the invention it would have been obvious for one skilled in the art to combine Aiello with Gase such that the server (*i.e.*, queue manager) of Aiello was encapsulated in a printer, and that the suggestion or motivation for doing so would have been to consolidate the server

functionality inside a printer device. However, the Applicant respectfully asserts that the combination of Aiello's teachings with Gase's teachings would be unobvious.

Specifically, "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 167 L.Ed.2d 705 (April 30, 2007). Thus, "the device [must be] uniquely challenging or difficult for one of ordinary skill in the art or represent an unobvious step over the prior art." *Id.*

As discussed previously, one or more embodiments of the claimed invention teaches a first printer and a second printer, the first printer having the capability to provide a print acceptance screen to a client computer used for printing data acquired from a peripheral device on, e.g., a second printer (*i.e.*, without having to first send the data back through the client computer). Thus, the claimed invention has steered away from the previously taught notion that data must be sent via a workstation from a data storage device to a printer, and has set up the system in such a way where one of the printers has the capability to provide a print acceptance screen and be used for printing as well. Indeed, the "unobvious step" provided by the claimed invention is the consolidating of a printer with the ability to provide a print acceptance screen where data need not be sent via the client computer, thereby allowing increased bandwidth for other functions that are necessary to perform over a network.

In contrast, Aiello is directed to a method for open systems printing including routing print jobs automatically from different types of source computers to different types of printers via a queue manager without the source computers selecting printers for each print job. *See e.g.*, Aiello, column 1, lines 49-52. The advantage taught by Aiello involves increased efficiency of routing an arbitrary number of print jobs from dissimilar/similar source computers to an arbitrary

number of dissimilar/similar high speed printing hardware. Thus, Aiello is directed to having one component (*i.e.*, queue manager) receive all the data for printing from numerous source computers for routing to various printers for increased efficiency.

However, the Applicant respectfully submits that one of ordinary skilled in the art would not have been motivated to combine Aiello with Gase. Specifically, encapsulating the queue manager into a printer, as the Examiner suggests, appears to be a useless action, as the printing portion of the queue manager would never be used for printing. Specifically, the purpose of Aiello is to increase efficiency by consolidating all the jobs at one location, and then routing them to various printers for printing. If the queue manager was *also used for printing*, decreased efficiency would result as printing may interfere with its main task of routing jobs to various other printers. Decreased efficiency would be the opposite of the advantage Aiello aims to achieve (*i.e.*, increased efficiency). Accordingly, there is no motivation to combine Aiello and Gase to consolidate the server functionality inside a printer device. Further, Maeda does not supply that which Aiello or Gase lacks as Maeda is only relied upon to teach a print request that specifies a peripheral device. *See* Office Action mailed June 15, 2007, page 3. Maeda is completely silent with respect to two printers, and to a printer having the capability to provide a print acceptance screen to a client computer.

In view of the above, Aiello, Gase, and Maeda, whether considered separately or in combination, fail to teach or suggest all the limitations of amended independent claim 13. Thus, amended independent claim 13 is patentable over Aiello, Gase, and Maeda. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 04783/012001).

Dated: September 17, 2007

Respectfully submitted,

By  _____

Jonathan P. Osha
Registration No.: 33,986
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant